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In re Application of
ESCH, Uwe *et al*
U.S. Application No.: 09/331,705
PCT No.: PCT/EP97/05792
Int. Filing Date: 21 October 1997
Priority Date: 19 December 1996
Attorney's Docket No.: 2698/Meinke/PCT
For: HYDRAULIC CIRCUIT FOR A
HYDRAULIC EXCAVATOR

DECISION

This decision is in response to applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" ("Pet.") filed 09 November 2000.

BACKGROUND

On 21 October 1997, applicants filed international application PCT/EP97/05792 claiming priority to a German patent filed 19 December 1996. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office ("PTO") on 25 June 1998.

On 25 March 1998, a Demand was filed with the International Preliminary Examination Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. Accordingly, the deadline for submission of a copy of the international application and payment of the basic national fee was extended to expire thirty months from the priority date, *i.e.*, 19 June 1999.

On 18 June 1999, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, an English translation, a small entity statement, authorization to charge the basic national fee and any additional fees to Deposit Account No. 06-0923, and an executed declaration.

On 28 July 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) to applicants indicating that the declaration submitted was not in

compliance with 37 CFR 1.497 because it did not identify the citizenship of each inventor. A one-month time period for response was set.

On 13 August 1999, applicants purportedly submitted a "Response to Notification of Missing Requirements."

On 18 February 2000, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicants failed to respond to the Form PCT/DO/EO/905 within the time period set.

On 09 November 2000, applicants submitted the instant petition which was accompanied by, *inter alia*, a copy of the response purportedly mailed 13 August 1999, a copy of a page of a declaration and authorization to charge all required fees to Deposit Account No. 50-1290.

DISCUSSION

A review of the above-captioned application reveals that the citizenship of the second inventor listed on the declaration submitted 18 July 1999, Gottfried Driesschner, was not listed in German, or otherwise. Accordingly, the declaration is not in compliance with 37 CFR 1.497.

Withdraw Holding of Abandonment

Counsel points out in the instant petition that a "Response to Notice of Missing Requirements Under 35 U.S.C. § 371 had in fact, been timely filed." Pet. ¶ 1. Therefore, the instant petition will also be treated as a request to withdraw the holding of abandonment.

MPEP § 503 lists procedures to ensure receipt of any paper filed in the PTO. Applicants must enclose a self-addressed postcard identifying all of the papers filed. The PTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

In this case, applicants have not provided a copy of the date-stamped filing receipt for the documents purportedly submitted 13 August 1999.

Accordingly, applicants have not provided *prima facie* evidence that a document titled "Response to Notice of Missing Requirements Under 35 U.S.C. § 371" was filed 13 August 1999.

Petition to Revive

Applicants alternatively requests to revive the unintentionally abandoned application. A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be accompanied by (1) a proper reply, unless previously filed, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Applicants state that "the entire delay in filing the necessary reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). The petition fee and surcharge fee for furnishing the declaration late pursuant to 37 CFR 1.492(e) have been charged to Deposit Account No. 50-1290 as authorized. A terminal disclaimer is not required in this application.

However, applicants have not submitted a proper reply. The above-captioned application was abandoned for failing to provide a declaration in compliance with 37 CFR 1.497. Applicants still have not furnished an acceptable declaration. The declaration submitted with the instant petition is not a complete declaration. It is only a partial declaration and does not meet all of the requirements of 37 CFR 1.497.

Accordingly, all requirements under 37 CFR 1.137(b) have not been satisfied.

DECISION

In view of the discussion mentioned above, applicants' request to withdraw holding of abandonment and petition to revive pursuant to 37 CFR 1.137(b) are both **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. A proper response must include a declaration in compliance 37 CFR 1.497. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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